

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on January 11, 2005, the Examiner rejected claims 1-4, 6-9, 12-16, 18, 21, 23-25 and 28-30 under 35 U.S.C. §112, second paragraph, and rejected claims 1-4, 6-9, 12-16, 18, 21, 23-25 and 28-30 under 35 U.S.C. §103(a). Accordingly, Applicant respectfully provides the following:

A. Rejection under 35 U.S.C. § 112, second paragraph

In the Office Action, the Examiner rejected claims 1-4, 6-9, 12-16, 18, 21, 23-25 and 28-30 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner has indicated that claims 18, 21 and 23 depend from canceled claim 17 which is improper. Applicant has respectfully amended claim 18 to be dependent from claim 14 instead. The Applicant respectfully submits that this Amendment overcomes this rejection made by the Examiner under 35 U.S.C. § 112, second paragraph.

The Examiner further indicates that it is not clear how the tracking of a users completed training is useful to the other modules of the system, thereby raising the question of how truly integrated such tracking is in other system modules. In addition to the disclosure found on page 7 of the specification, noted by the Examiner, pages 10 and 11 contain disclosure regarding the integration between tracking a user's completed training and other modules of the system. In particular, the specification indicates that a training module may be initiated, whereby a user would be taught a procedure for accomplishing this specific task. The training information, which may be comprised of information on the users specialized tools, specialized parts or components needed to complete the task may be assembled into complete task information database. The specification further indicates that the task information database may be utilized

in both the estimation and purchasing models to aid the user in determining whether the task would be economically viable in completing the task himself/herself rather than seeking professional services. The more experienced or the more training a do-it-yourselfer has undergone, the less expensive a given project would be. Accordingly, the present invention discloses an invention wherein tracking information related to training programs is integrated with other modules of the system, for example, the estimating and purchasing modules. Applicant respectfully submits that the remarks provided herein overcome the rejections made by the Examiner under 35 U.S.C. § 112, second paragraph.

B. Rejections under 35 U.S.C. 103

The Examiner rejected claims 1-4, 6, 9, 12 and 13 under 35 U.S.C. §103(a) as being unpatentable over the article “Best Man: Do It Best Corp., Based in Fort Wayne, is a \$2.2 Billion National Hardware Cooperative” (hereinafter “Kaelble”) in view the article “These Old Web Sites” (hereinafter “Pack), and rejected claims 7, 8, 14-16, 18, 21, 23-25, and 28-30 under 35 U.S.C. §103(a) as being unpatentable over Kaelble in view of Pack and further in view of the article “The Pitfalls of Doing it Yourself” (hereinafter “Porter”). Applicant respectfully submits that the claim set as provided herein is not made obvious by the cited references.

There are several arguments that support the patentability of the present invention. First, the Examiner must treat the claimed invention as a whole. Viewed as a whole, the presently claimed method would not at the time of the invention be obvious to one skilled in the art. Second, the prior art does not teach each and every element of the invention as recited in the amended claims. Third, the prior art does not suggest the combination of the prior art references cited against the present invention.

1. The Invention Viewed as a Whole is Not Obvious

Examiner must treat the claimed invention as a whole. In determining the differences between the prior art, and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530 (Fed. Cir. 1983). It is inappropriate to identify particular elements of the present invention and then to subsequently dismiss the methods as well known in the art. In the case at hand, the Examiner separated the invention into its constitutive elements and has utilized the combination of three pieces of prior art, without suggestion in the art to combine, to indicate that the several elements of the claim set, each viewed in isolation, were present in the prior art. Further, where the element was not taught by one of the prior art references the Examiner has rejected the element, viewed in isolation, as obvious and because the element viewed in isolation is allegedly well known in the art. In effect the Examiner has dismantled the invention and had discredited individual elements without evaluating the invention as a whole.

Accordingly, Applicant respectfully posits that it is inappropriate to merely state that an isolated element of the invention is well known in the art without viewing the element as part of a whole. For example, it is inappropriate to merely state that the isolated element of performing interactive online training is well known in the art, without viewing that claim limitation as a part of the whole invention. While the naked assertion that online training existed prior to this invention may contain truth in isolation, it is not true that interactive online training as claimed by the present invention was well known in the art at the time. This truth is evidenced by the fact that none of the art cited by the Examiner suggested the utilization of interactive online training utilized to test a user's retention of the training material in order to assess the competence of a user to carry out tasks associated with the training material with the other elements presently

claimed by the invention. Kaelble poses the hypothetical question “[w]hat could be cutting edge about a business as old and traditional as the neighborhood hardware store?” and answers “[p]lenty.” The business practices described by Kaelble were cutting edge at the time of its disclosure. Kaelble described business practices existing only four months before the present application was filed. Kaelble was cutting edge, but Kaelble failed to disclose and utilize the concepts presently claimed in this application.

Additional examples of singling out isolated elements of the claim set and discrediting them as obvious to one skilled in the art, include the statement that: “[i]t is old and well known in the art to automatically pass relevant data back and forth from distinct computer modules in order to mitigate the need to repeatedly enter the same data by hand, thereby saving time and reducing the potential for error normally associated with manual data entry”; “[i]t is old and well known in the art to track and communicate records of users completed training”; and “[i]t is old and well known in the art to utilize a computer to perform calculations commonly performed by hand in order to complete such calculations with greater speed and accuracy”. It may be well known in the art that automatically passing data creates efficiencies, but it would not have been obvious to one skilled in the art to pass the information currently recited by the present invention. An isolated claim element by itself may be obvious, but when the invention is viewed as a whole, the claim limitation contributes to recitation of claim elements that are not obvious in view of the art.

2. The References Do Not Teach or Suggest All the Limitations Recited in the Present Invention

Applicant respectfully submits that the references cited by the Examiner do not teach or suggest all the limitations claimed in the present invention. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991). For purposes of analysis Applicant has focused the following discussion particularly on

independent claim 1 as provided herein and respectfully submits that none of the references cited by the Examiner, alone or in combination teach or suggests such limitations. In particular, Applicant respectfully submits the references cited by the Examiner do not teach (1) “integration” of the constitutive elements recited in the independent claims of the invention; (2) interactive training, (3) “tracking training said user has received for performing said tasks” and (4) selectively transmitting to another module of the integrated system information related to training said user as received for performing said task.

None of the references cited by the Examiner alone or in combination teach integrating the constitutive elements of the presently claimed invention. Integration is a claim limitation recited in each of the independent claims of the presently claimed invention. The Examiner has cited three pieces of prior art which independently disclose portions of the presently claimed invention. However, none of the cited art teaches or suggests the integration of all of the elements of the claims of the present invention. For example, Pack and Kaelble are clear snapshots of the art of the time. What they lack is integration of disparate elements. Pack references more than ten websites. None of them teach the elements of the present invention and there is no suggestion to combine or to create the present invention. Why? The invention was not obvious to one skilled in the art at the time of Kaelble’s disclosure.

None of the references cited by the Examiner teach or suggest “interactive training.” The independent claims of the present invention all contain the claim limitation for interactive training. The Examiner indicates in Section 7 of the Office Action that Kaelble discloses “a training module selectively executed by one or more computer devices for providing training to users regarding how to perform said tasks.” However, Kaelble discloses what is stylized as “cutting edge” at the time, a site which “offers not only products, but do it yourself advice and

project tips including articles and video clips.” Likewise, Pack discloses that training elements were available at the time, but that those training elements were a disappointment because you could only “read FAQs, browse Bob’s tips or post questions.” Pack, at para. 8. Thus, the art disclosed by the Examiner indicates that training videos were available, but teach away from interactive training devices for providing training to a user regarding how to perform said tasks.

None of the references only or in combination with each other teach or suggest “tracking training said user has received for performing said tasks.” The Examiner indicates that it is old and well known in the art to track and communicate a record of user’s completed training. Office Action, at 9. However, the Examiner indicates “this specific tracking of a user’s completed training is not needed as an input to the functions performed by other system modules, such as estimating and purchasing modules.” Office Action, at 8. Viewed in isolation tracking a user’s completed training may appear obvious to the Examiner, but the Examiner’s statements that such tracking is not useful as recited in the present invention is indicia of the nonobvious characteristics of the presently claimed invention. It was not well known in the art to track and communicate a record of a user’s completed training, in association with the skill set disclosed in the present invention, and more importantly it is not obvious that a specific tracking of the user’s completed training would be utilized as input to functions performed by other system modules claimed in the present invention for estimating and purchasing. Accordingly, when viewed as a whole of the art cited by the Examiner fails to teach tracking and recording training received by a user.

None of the references cited by the Examiner alone or in combination teach or suggest transmitting a record of training received by user to another module or an integrated system. Again the Examiner indicates that it is well known in the art to communicate a record of a users

completed training. However, as discussed above when this constitutive claim element is viewed as a whole the art cited by the Examiner fails to teach tracking and recording training received by a user.

Accordingly, Applicant respectfully submits that for at least the reasons provided herein, the references cited by the Examiner, alone or in combination, do not teach or suggest all the limitations claimed in independent Claim 1. Further, independent claims 14 and 30 include similar limitations, which are not taught or suggested by any of the references alone or in combination. Because the references cited by the Examiner do not teach or suggest each and every limitation of independent claims 1, 14 and 30, Applicant respectfully submits that the prior art references do not make obvious the independent claims as provided herein. Because the prior art references do not make obvious independent claims 1 and 14, Applicant respectfully submits that the prior art references cited by the Examiner do not make obvious the corresponding dependent claims, which depend from and provide further limitations to independent claims 1 and 14.

3. There Is No Suggestion In the Art to Combine the Referenced Cited Against the Present Application

The prior art does not suggest the combination of references cited against the present invention. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." In re John R. Fritch, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Any such suggestion must be "found in the prior art, and not based on applicant's disclosure." In re Vaeck, 947 F.2d 488, 493 (Fed. Cir. 1991). Indeed, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the

desirability of the modification.” In re Mills, 916 F.2d 680, 682 (Fed. Cir. 1990). A “clear and particular” showing of the suggestion to combine is required to support an obviousness rejection under Section 103. MPEP § 2142.

Applicant urges that the combination of the listed references is not a product of a suggestion contained within them, but a product of inappropriate hindsight analysis. "Hindsight reconstruction" cannot be used "to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." Ecolochem, Inc. v. S. California Edison Co., 227 F.3d 1361, 1371 (Fed. Cir. 2000). Rather, "the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references." Id. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability-the essence of hindsight." Id. Applicant submits that the prior art fails to clearly and particularly suggest the combination indicated by the Examiner. Thus, Applicant's claims are not obvious in view of the prior art references.

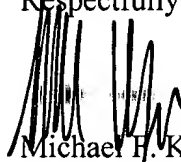
In light of the absence of any suggestion or motivation to combine the above-referenced prior art, the mere fact that such prior art could be combined in the manner suggested by the Examiner does not render the present invention obvious. MPEP § 2142. Moreover, in this case the combined references fail to produce or suggest each element of the claimed invention. Accordingly, Applicant respectfully submits that for at least the reasons provided herein, the claim set as provided herein overcomes all rejections made by the Examiner in the Office Action.

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 11 day of April, 2005.

Respectfully submitted,



Michael F. Krieger
Attorney for Applicant
Registration No. 35,232

KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 321-4814
Facsimile: (801) 321-4893

810345